

REMARKS

Claims 2-33 are pending. Claims 2-5 are currently under examination. Claims 6-33 have been cancelled. Claim 5 has been amended. The specification has been amended to provide proper demarcation of trademarks. Support for the amendments can be found throughout the specification and the claims as filed. Accordingly, these amendments do not raise an issue of new matter and entry thereof is respectfully requested. Entry of the proposed amendments is respectfully submitted to be proper because the amendments are believed to place the claims in condition for allowance.

Regarding the Declaration

In the Office Action, it is indicated that the oath or declaration is defective for not reciting “the named inventor or inventors.” Applicants respectfully traverse and note that the Declaration previously submitted is a copy of the Declaration as filed in parent application serial No. 09/934,102, which issued as U.S. Patent No. 6,696,558, and was therefore clearly considered to be in compliance with the requirements of 37 C.F.R. § 1.67(a). Nevertheless, to further prosecution, submitted herewith is a new Declaration executed by the inventors.

Regarding the Notice of Non-Compliant Amendment

The Office Action indicates that the previous amendment was non-compliant because the amendment to the abstract did not appear on a separate page. As requested by the Examiner, the abstract page has been amended and submitted on a separate page. Accordingly, Applicants respectfully submit that the present amendment to the abstract is in compliance.

Objections to the Specification

The Office Action indicates that the objection to the specification has been maintained because trademarks are not properly demarcated. Applicants apologize for the oversight of additional trademarks requiring demarcation that were inadvertently overlooked in the previous response. The specification has been amended to demarcate additional trademarks. Accordingly, Applicants respectfully request that the objection to the specification be withdrawn.

Regarding Double Patenting

The rejection of claims 2-5 for obviousness-type double patenting over claims 1 and 2 of U.S. Patent No. 6,696,558 is respectfully traversed. Applicants submit herewith a duly-executed terminal disclaimer over Patent No. 6,696,558. Additionally submitted herewith as Exhibit 1 is a copy of the Statement under 3.73(b) executed by the assignee and filed in parent application 09/934,142. Applicants respectfully submit that the double patenting rejection has been rendered moot by the filing of the terminal disclaimer. As stated by the Court of Appeals for the Federal Circuit, the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection," *Quad Environment Technologies Corp. v. Union Sanitary District*, 20 USPQ2d 1392 (Fed. Cir. 1991). Thus, Applicants request that the double patenting rejection be withdrawn.

Rejection Under 35 U.S.C. § 112, First Paragraph

The rejection of claim 5 under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement is respectfully traversed. Applicants respectfully submit that the specification provides sufficient description and guidance to enable the claimed method. Nevertheless, to further prosecution, claim 5 has been amended as suggested by the Examiner. Applicants appreciate Examiner Rawlings' suggestion for obviating the rejection. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Rejection Under 35 U.S.C. § 102

The rejection of claims 2-5 under 35 U.S.C. § 102(a) as allegedly anticipated by Takayama et al., GENEMBL Accession No. AF022224, is respectfully traversed. Applicants respectfully submit that the claimed methods are novel over Takayama et al. Submitted herewith as Exhibit 2 is a Rule 132 Declaration signed by the inventors attesting that the co-authors of the Takayama et al. reference worked under the inventors' direction and supervision. Therefore, Applicants respectfully submit that the Takayama et al. reference is not applicable as prior art and that this rejection has been rendered moot. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Application No.: 10/782,627

In light of the amendments and remarks herein, Applicants submit that the claims are now in condition for allowance and respectfully request a notice to this effect. The Examiner is invited to call the undersigned agent if there are any questions.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

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Date: May 12, 2008

**Please recognize our Customer No. 41552
as our correspondence address.**

EXHIBIT 1

STATEMENT UNDER 37 C.F.R. § 3.73(b)

Title of Application: NOVEL BAG PROTEINS AND NUCLEIC ACID
MOLECULES ENCODING THEM.

Application Ser. No.: 09/394,142

Filed: September 9, 1999

Inventor(s): Reed and Takayama

Attorney Docket No.: P-LJ 3737

The Burnham Institute, a non-profit corporation, states that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of an assignment from the inventors of the application. A copy of the executed assignment, submitted for recording, is attached hereto as documentary evidence of the chain of title to the assignee.

The undersigned is empowered to sign this statement on behalf of the assignee.

Date: 10-27-99

Signature: 

Name: Cheryl A. Moore

Vice President

Title: Chief Administrative Officer

EXHIBIT 2

Docket No.: 066821-0276

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 41552
	:	
Reed, John C., et al.	:	Confirmation Number: 5834
	:	
Application No.: 10/782,627	:	Group Art Unit: 1643
	:	
Filed: February 18, 2004	:	Examiner: Rawlings, Stephen L.
	:	
For: NOVEL BAG PROTEINS AND NUCLEIC ACID MOLECULES ENCODING THEM		

Declaration Pursuant to 37 C.F.R. § 1.132

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

We, the undersigned, declare as follows:

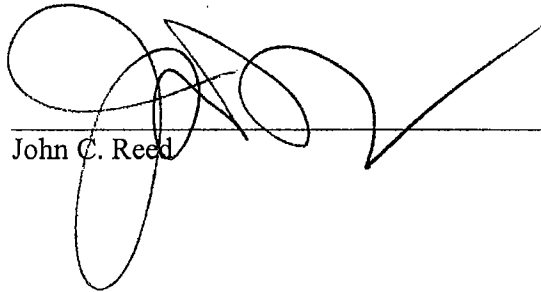
- 1) We are the John C. Reed and Shinichi Takayama who are named as co-inventors on the above-identified patent application.
- 2) We understand that the claims stand rejected, in part, as allegedly anticipated by Takayama et al., GenBank accession No. AF022224.
- 3) We, John C. Reed and Shinichi Takayama, are co-authors of Takayama et al. The remaining authors, K. Kochel, S. Irie, J. Inazawa, T. Abe, T. Sato, T. Druck and K. Huebner, worked under our direction and supervision.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States

Code and that any such willful false statement may jeopardize the validity of the application or any patent issued thereon.

Date

John C. Reed

A handwritten signature in black ink, consisting of several overlapping loops and a long, sweeping horizontal stroke at the end, positioned over a horizontal line.

Date

Shinichi Takayama

10/782,627

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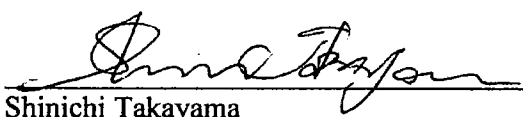
Code and that any such willful false statement may jeopardize the validity of the application or any patent issued thereon.

Date

John C. Reed

5/6/08

Date



Shinichi Takayama